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10/630,461	07/30/2003	Lynda Fengler	200301157-1	9160

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EXAMINER	
INGBERG, TODD D	

ART UNIT	PAPER NUMBER
2193	

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/630,461	FENGLER ET AL.	
	Examiner	Art Unit	
	Todd Ingberg	2193	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 April 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-34 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-34 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 7/30/2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claims 1 – 34 have been examined.

Drawings

1. Figure 1 should be designated by a legend such as --Prior Art-- because only that which is old is illustrated. See MPEP § 608.02(g). Corrected drawings in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the Examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance. Applicant appear to agree but **failed to provide a new drawing**. Examiner agrees with Applicant's argument for Figures 2 and 3 as not being prior art. Examiner never deemed them as prior art just viewed them as clearly depicting the invention in the context of the environment.

Specification

2. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed. Legal words like method and system should be removed.

Claim Rejections - 35 USC § 101

3. Part of the prior rejection under 35 U.S.C. 101 has been overcome by a recent change in Office policy.
4. Applicant's response on page 11 of the Response clarifies for the record the Applicant is not claiming a signal and clarified the Applicant's prior arguments.

Claim Rejections - 35 USC § 112

5. The rejection under the first paragraph of 35 U.S.C. 112 is withdrawn in view of Applicant's clearer arguments under the response on page 11 of the response.

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6. In response to Applicant's remarks about appealing, the Applicant has the right to appeal after two Office actions.

7. Claim 10 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The limitation "small" is indefinite. One of ordinary skill in the art would not know the clear and concise meaning of a small message. The limitation has no patentable weight.

Double Patenting

8. The Terminal Disclaimer has been accepted.

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 1- 3 and 5 - 34 are rejected under 35 U.S.C. 103(a) as being unpatentable over the commercial product by Hewlett Packard, known as OpenView (Also, sold by Computer Associates under the name UniCenter TNG – see HP, page 189), as taught by Nathan Muller in the text book, "Focus on HP OpenView A Guide to Hewlett-Packard's Network and Systems Management Platform" (Referred to as HP), published March 1995 in view of USPN #6,467,087, Yang filed December 16, 1999.

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Claim 1

A methods for facilitating installation of firmware on a printing device, the method comprising: transmitting from a computer a notification that firmware is available for installation on a printing device; receiving with the computer a firmware download request; and transmitting a firmware file directly to the printing device to enable installation of the firmware on the printing device.

Rejection for Claim 1

HP is a commercial product which is also sold as Computer Associates UniCenter TNG (HP, page 189), that teaches managed environments to provide Network and System Management (HP, page 1). HP provides the ability to download firmware (HP, pages 256, 116). HP supports the ability to execute actions such as PUSH (locally executed) or PULL operations (remote execution) of actions by providing the ability to execute actions locally or remotely in support of the environment (HP, Action Execution, page 69). And provides communications with messaging to intelligent network devices/ peripheral such as printers (HP, page 67, message allowed). In addition to the enabling of messaging to devices HP supports the use of email to support operations of the managed environment (HP, pages 130, 165). HP provides for tracking changes on remote devices and registers the information (HP, pages 164, 193) and determining the status of hardware, software and firmware (HP, Auto Discovery, page 164 and HP, Change Orchestration, page 184). Downloads and configurations of what is installed and the dependencies of installed products is maintained in HP OpenView (HP, page 182 – Software Management and HP, page 179 - 181, Software Distributor and Distribution Overview , Distribution Depots, Target System). Although, HP provides the infrastructure to support intelligent devices. the reference does not explicitly teach a printer requesting a download and installing on the printer the firmware update. It is Yang who explicitly teaches the updating of the firmware on a printer (Yang, Abstract). And Yang teaches the request for update coming from the printer (Yang, col 2, lines 20-25). therefore, it would have been obvious to one of ordinary skill in the art at the time of invention to take the infrastructure and capabilities of HP OpenView and support the ability of Intelligent peripherals as taught by Yang and enable Intelligent peripherals to be supported in the managed environment, because “.. users can self update firmware of the printer... (Yang, col 2, lines 20-23).

Claim 2

The method of claim 1, wherein transmitting a notification comprises transmitting a notification directly to the printing device.

Rejection for Claim 2

HP teaches the ability to communicate with intelligent devices (HP, page 67) and the ability to determine changes in the environment by tracking ongoing changes and dynamically updates the map to reflect those changes (HP, page 164). Therefore, it would be obvious to one of ordinary skill in the art at the time of invention to utilize the features of HP OpenView to support the updating of intelligent devices/ peripheral by tracking changes (See claim 1), determining updates based on gathered information (HP, see claim 1) and downloading firmware updates to an intelligent device (printer). Because keeping managed environments up to date with automated change management (HP OpenView), saves money.

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Claim 3

The method of claim 1, wherein transmitting a notification comprises transmitting an email to the user. HP teaches the use of email messages to support the managed environment (HP, pages 130, 165). The use of sending an email to support operations such as notifying a user of an update is deemed intended use of email and taught by the HP reference.

Claim 5

The method of claim 1, wherein receiving a firmware download request comprises receiving a firmware download request transmitted is the computer from the printing device. (Yang, col 2, lines 20-25).

Claim 6

The method of claim 1, wherein transmitting a firmware file comprises transmitting a remote update (RFU) file directly to the printing device. HP, stores the code to update in the Software Distribution system for each target system (HP, pages 179-181).

Claim 7

The method of claim 1, further comprising registering the printing device with a firmware service (HP, page 68, collecting data from managed nodes and HP, page 164, Auto Discovery) and determining whether to transmit a notification based upon information that was collected through registration of the printing device (HP, pages 76 – 79).

Claim 8

A system for facilitating installation of firmware on a printing device the system comprising:
means for transmitting a notification to a device indicating that new firmware is available for installation on the printing device;
means for receiving a firmware download request; and
means for transmitting a firmware file directly to the printing device.

As per claim 1.

Claim 9

The system of claim 8, wherein the means for transmitting a notification comprise means for transmitting a notification directly to a printing device. As per claim 2.

Claim 10

The system of claim 8, wherein the means for transmitting a notification comprise means for transmitting an email message to a user, the email message including a link to a network page at which firmware download can be requested. As per claim 4.

Claim 11

The system of claim 8, wherein the means for transmitting a firmware file comprise means for transmitting a remote firmware update (RFU) file to the printing device. As per claim 6.

Claim 12

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The system of claim 8, further comprising means for registering a printing device with a firmware service. As per claim 7.

Claim 13

A method for facilitating installation of firmware on a printing device, the method comprising: a peripheral device receiving a firmware availability notification; and the printing device providing a related notification to a user.

Examiner Rejection

Official Notice is taken that devices such as printers often support the ability to make audible sounds such as a “Bell” sound (Ctrl G, ASCII). And that one of ordinary skill in the art at the time of invention would know how to incorporate the ability to incorporate an audible sound in their message, thus notifying a user as a form of notification.

Claim 14

The method of claim 13, wherein the printing device providing a related notification to a user comprises the printing device providing a notification on a network page (HP, page 77, Message Browser) using a network server embedded in the printing device (Yang, Col 2, lines 39-43 also part of HP – claim 1 – intelligent peripheral).

Claim 15

The method of claim 13, wherein the printing device providing a related notification to a user comprises the printing device transmitting a message to a user computing device. (Yang, col 2, lines 20-25).

Claim 16

The method of claim 13, wherein the printing device providing a related notification to a user comprises the printing device displaying a notification in a display of the printing device. (HP, communications to intelligent peripherals of claim 1 and notifications in OpenView in claim 1 and the printing of the notification on the printer (Note – “display of the printer device” – can display of a message.)

Claim 17

The method of claim 13, further comprising the printing device receiving a request to install available firmware. (As per claim 1, see the ability to perform PUSH operations and communicate with intelligent peripherals)

Claim 18

The method of claim 17, further comprising the printing device transmitting a firmware download request to a firmware service. (HP as per claim 1, the ability to execute remotely and Yang, col 2, lines 20-25).

Claim 19

The method of claim 18, further comprising. the printing device receiving a firmware file and installing the firmware on the printing device. (Yang, Figure 2, #206)

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Claim 20

A system for facilitating installation of firmware on a printing device, the system comprising:
means provided on a printing device for receiving a notification from a firmware service that new printing device firmware is available for download; and means provided on the printing device for providing a related notification to a device user. As per claim 1.

Claim 21

The system of claim 20, wherein the means for providing a related notification comprise an embedded network server of the printing device that is configured to post a notification on a network page. See claim 14.

Claim 22

The system of claim 20, wherein the means for providing a related notification comprise means for transmitting a message from the printing device to a user computing device. As per claim 15.

Claim 23

The system of claim 20, wherein the means for providing a related notification comprise means for displaying a notification in a display of the printing device. As per claim 16.

Claim 24

The system of claim 20, further comprising means for receiving and installing a firmware file on the printing device. As per claim 19.

Claim 25

A computer readable medium that contains a firmware service, the service comprising:
logic configured to transmit firmware availability notifications directly to the printing devices;
logic configured to receive firmware download requests from the printing device; and logic configured to transmit firmware files directly to the printing devices.
See the rejection for claim 1, claim 5 and claim 6.

Claim 26

The computer readable medium of claim 25, wherein the logic configured to transmit firmware files comprises logic configured to transmit remote firmware update (RFU) files directly to the printing devices. As per claim 6.

Claim 27

The computer-readable, medium of claim 25, further comprising logic configured to register printing devices with the firmware service. As per claim 7.

Claim 28

The computer-readable medium of claim 27, further comprising logic configured to determine whether to transmit firmware availability notifications based upon collected printing device registration information. As per claim 7.

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Claim 29

A printing devices, comprising: memory including logic configured to directly receive firmware availability notifications that are transmitted by a firmware service via a network; and logic configured to provide related notifications to a user. As per claims 1, 2 and 3.

Claim 30

The printing device of claim 29, wherein the logic configured to provide related notifications comprises an embedded network server that is configured to post notifications on network pages accessible via a network browser. See claim 14.

Claim 31

The printing device of claim 29, wherein the logic configured to provide related notifications comprises logic configured to transmit email messages to a user computing device that indicate that firmware is available for installation. As per claim 3.

Claim 32

The printing device of claim 29, further comprising a display and wherein the logic configured to provide related notifications comprises logic configured to present notifications in the display. As per claim 16.

Claim 33

The printing device of claim 29, further comprising logic configured to receive a firmware installation request and logic configured to transmit a firmware download request to the firmware service. As per claim 1.

Claim 34

The printing device of claim 33, further comprising logic configured to receive and install firmware files. As per claim 19.

11. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over HP and PTR as applied to claims 1 –3 and 5 - 31 above, and further in view of USPN #6,424,424 Lomas, filed January 19, 1999.

Although, HP OpenView disclosed Motif (HP, page 164 and 190) and Yang's intelligent peripheral communicates on a network. Neither disclose the use of a link in an email. It is Lomas who teaches the use of the use of an embedded link in an email for a network printer (Lomas, Abstract and Figure 1). therefore, it would have been obvious to one of ordinary skill in the art at

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the time of invention to combine HP, Yang and Lomas, because the embedded link in email provides a means of giving instruction for installation (Lomas, col 1, lines 30-42).

Claim 4

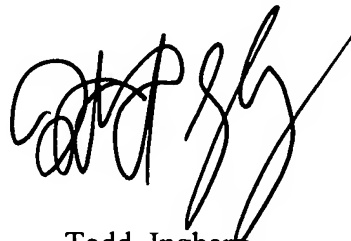
The method of claim 3, wherein transmitting an email message to a user comprises transmitting a link to a network page at which firmware download can be requested

Correspondence Information

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Todd Ingberg whose telephone number is (571) 272-3723. The examiner can normally be reached on during the work week..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Meng-Ai An can be reached on (571) 272-3756. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Todd Ingberg
Primary Examiner
Art Unit 2193